REMARKS

I. Introduction

In response to the Office Action dated October 3, 2005, the claims have not been amended. Claims 1-29 remain in the application. Re-examination and re-consideration of the application is respectfully requested.

II. Prior Art Rejections

On page (2) of the Office Action, claims 1-29 were rejected under 35 U.S.C. §103(a) as being unpatentable over "Microsoft Windows NetMeeting 3," http://www.microsoft.com/windows/NetMeeting/Features/default.asp (NetMeeting) and Schilit et al., U.S. Patent No. 6,687,876 (Schilit).

Specifically, the independent claims were rejected as follows:

> Regarding claims 1 and 20, NetMeeting teaches receiving, in a first client, an identification of a second client to initiate a chat session with, initializing a chat session across a network between the first client and the second client, displaying a graphical image on the first client (all taught as part of the video and audio conferencing capabilities of NetMeeting, on page 2 and the chat feature of page 3), selecting a command to markup the graphical image (taught as the use of selectable drawing tools on a shared Whiteboard, on page 4), and transmitting the markup file across the network to the second client through the chat session (inherent to the program to allow users at different workstations to view edits to the graphical images). Furthermore, NetMeeting teaches markup editing toolbar (see the left side of the Whiteboard image) similar to that used by Microsoft Paint. The toolbar clearly allows for different markup entities, such as freeform drawings, text, and geometric objects.
>
> NetMeeting does not explicitly teach in response to the command, storing markup information in a markup file separate from the graphical image, a source reference that identifies the graphical image, and an orientation that indicates how the graphical image should be displayed with regard to the markup entity.
>
> Schilit teaches a method for maintaining freeform ink annotations similar to those found in NetMeeting. Furthermore, Schilit teaches the separation of annotations from the original display (the annotation database of col. 14, lines 4-8), which are inherently related to an identified source image, and an orientation that indicates how the graphical image should be displayed with regard to the markup entity (taught as the relation of stored annotation strokes and anchor points to their relevant locations on a document, at col. 14, lines 8-49).
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> Therefore, it would have been obvious to one of ordinary skill in the art, having the teachings of NetMeeting and Schilit before him at the time the invention was made to modify the markup chat sessions of NetMeeting to include the separation of an original source image with its annotations in order to obtain a chat markup system where annotations are stored separately from their source images.
>
> One would be motivated to make such a combination for the advantage of maintaining the integrity of an original image to be annotated through the use of a transparent markup image, or the possibility of having more than one markup file related to a given image, instead of multiple copies of an original image with annotations, thus conserving storage space.

> Regarding claim 11, NetMeeting inherently teaches a first client computer and a display device connected to the first client computer. Furthermore, any modern-day computer with storage means is capable of storing a graphical image. NetMeeting shows an instant messaging application installed on a first client computer (the chat capabilities of page 3) and allows for a selectable command to markup a graphical image (the Whiteboard of page 4). Through the use of such chat and Whiteboard capabilities, NetMeeting allows for receiving an identification of a second client to receive the markup file, initializing a chat session across a network with the second client, transmitting the markup file across the network to the second client through the chat session, and displaying the markup entity in the orientation on the graphical image on the display device. Furthermore, NetMeeting teaches markup entities that specify a type of markup to be displayed, taught as the use of a graphic editing toolbar (see the left side of the Whiteboard image) similar to that used by Microsoft Paint. The toolbar clearly allows for different markup entities, such as freeform drawings, text, and geometric objects.
>
> NetMeeting fails to explicitly teach in response to the command, storing markup information in a markup file stored separately from the graphical image, a source reference that identifies the graphical image, and an orientation that indicates how the graphical image should be displayed with regard to the markup entity.
>
> Schilit teaches a method for maintaining freeform ink annotations similar to those found in NetMeeting. Furthermore, Schilit teaches the separation of annotations from the original display (the annotation database of col. 14, lines 4-8), which are inherently related to an identified source image, and an orientation that indicates how the graphical image should be displayed with regard to the markup entity (taught as the relation of stored annotation strokes and anchor points to their relevant locations on a document, at col. 14, lines 8-49).
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> One would be motivated to make such a combination for the advantage of maintaining the integrity of an original image to be annotated through the use of a transparent markup image, or the possibility of having more than one markup file related to a given image, instead of multiple copies of an original image with annotations, thus conserving storage space.

Applicant traverses the above rejections for one or more of the following reasons:

(1) Neither NetMeeting nor Schilit teach, disclose or suggest the storage of a markup information in a markup file separate from the graphical image in a chat session environment.

(2) Neither NetMeeting nor Schilit teach, disclose or suggest the combination of the chat session on a network with the markup techniques and file separation; and

(3) There is no motivation to combine NetMeeting with Schilit and even if combined, such a combination would still fail to teach the invention as claimed.

Independent claims 1, 11, and 20 are generally directed to marking up a graphical image in a chat session. After displaying a graphical image and selecting a command to markup the image, a separate markup file is created with markup information. The markup information comprises various items including a markup entity that specifies a type of markup to be displayed. The

information also includes a source reference and an orientation. The markup file is then transmitted across a network through the chat session and used to display the markup entity at the second client.

The cited references do not teach nor suggest these various elements of Applicant's independent claims. The Office Action admits that NetMeeting fails to teach the storage of the markup information in a markup file that is separate from the graphical image. To teach this claim element, the Office Action relies on Schilit's separation of annotations from the original display in an annotation database. The background of the present invention on page 4, lines 11-20 provides:

> The prior art mechanism for collaborating with another user regarding drawing changes is to email or transfer (e.g., by facsimile) an entire design document/drawing file including the markups to another user. For example, a user may markup a drawing on one computer, email or transfer the marked up drawing to another user, and then initiate a chat session with the other user to discuss the changes. However, graphic files involved in CAD applications and models are often very large. Accordingly, such a transmission mechanism is slow, time consuming, and inefficient. Further, such a mechanism involves multiple steps on behalf of the user. For example, a user must view the drawing and changes in one application and discuss the changes in a separate instant messaging application. Additionally, there is no mechanism for providing markups to a design document during an instant messaging application.

As can be seen from this text, the prior art has problems in multiple respects. These problems include a slow transmission time and multiple steps that must be performed on behalf of the user. Further, there is no mechanism to provide markups to the design document during an instant messaging application. The cited art fails to cure such deficiencies. In this regard the use of Schilit's annotation database (as discussed in more detail below) would require multiple steps that must be performed on behalf o the user. Further, the use of Schilit's annotation database would add multiple levels of complexity that would lead to an inefficient and non-operable result.

Applicants note that Schilit is not directed towards an instant messaging application whatsoever. In this regard, Schilit provides the ability to maintain freeform ink annotations on changing views. However, the ability to quickly and efficiently integrate such maintenance of freeform annotations with an instant messaging application is not even remotely attempted in Schilit. In fact, Applicants submit that Schilit teaches away from such a combination. Schilit explicitly provides for the use of an annotation database that stores anchored strokes. Thus, every time the user wishes to access an annotated stroke, add, an anchored stroke, delete an anchored stroke, etc., the user must access a database (see Schilit col. 8, lines 56-62). As is known in the art, a database is a set of related files that are created and managed by a database management system (DBMS).

Accordingly, the use of a database comes at the cost of requiring the installation, use, and maintenance of a DBMS. Such a DBMS controls access to/from the database.

In view of the above, it can be noted that since Schilit requires and utilizes a database, a DBMS system must be used by Schilit. The current claims do not require the use of a database. Further, the various steps of the claims would be incompatible with the use of a database. In this regard, the claims provide for transmitting the markup file across a network through the chat session. Further in response to the transmission, the markup entity is caused to be displayed. To utilize Schilit, the entire annotation database would have to be transmitted through the chat session. In addition, the receiving client of the annotation database would be required to have an installed DBMS that is configured to enable and allow access to the annotation database. Such a DBMS is not part of a chat session as required by the claims. Further, there is no suggestion to combine a database (or more specifically, Schilit's database) with an instant messaging application as claimed.

Thus, in view of Schilit's use of a database, a DBMS system would be required. The current claims do not require nor utilize either a database or a DBMS. Further, the use of a DBMS and database are incompatible with the current claims or the use of an instant messaging application.

In addition to the above, the motivation used to combine Schilit with NetMeeting is an advantage of maintaining the integrity of an original image to be annotated through the use of a transparent markup image, or the possibility of having more than one markup file related to a given image, instead of multiple copies of an original image with annotations, thus conserving storage space. MPEP §706.02(j) provides that "there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings." Applicants note that none of the advantages relied upon in the Office Action are recited or suggested in either Schilit or NetMeeting. Further, such advantages are not in the knowledge generally available to one of ordinary skill in the art. In addition, the mere advantage of maintaining the integrity of an original image to be annotated does not lead to any motivation to combine such maintenance with an instant messaging application.

Under MPEP 2143, it is the Examiner's obligation to set forth a prima facie case of obviousness. As part of establishing the case, the Examiner must meet three criteria: he must show that some suggestion or motivation, either in the references themselves or in the knowledge

generally avail-able to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Under these principles, Applicants submit that there is no motivation to modify either Schilit or NetMeeting in the manner suggested in the Office Action. Further, there is no reasonable expectation of success. In this regard, the NetMeeting application would require the use of a DBMS that is part of the chat session, and the transmission of an entire database across a network. Not only is there no expectation that such a combination would work (Applicants submit that such a combination would not work), but the motivation to make such a combination is wholly without merit.

In addition, under MPEP §2141.01, "The references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention". Applicant submit that the Office Action relies on such impermissible hindsight in combining NetMeeting with Schilit.

With respect to claims 6 and 25, the Examiner takes Official Notice that XML files are well known in the art to give a user the flexibility of tag customization for specific information. Applicants agree that XML files are well known in the art and provide flexibility for tag customization. However, as previously stated, the claims provide for the use of specific tags. Namely, a markup entity tag specifies a markup entity, a source reference tag identifies the graphical image, and an orientation tag specifies the orientation. While XML in general provides for the flexible use of tags, the specifically claimed tags are not obvious nor used in any of the cited references.

In addition, Applicants note that neither of the cited references even remotely suggest the use of XML. Accordingly, even if XML is known in the art, the suggestion or motivation to use XML in combination with NetMeeting or Schilit is completely lacking. Applicants submit that there would be no motivation to use XML with the NetMeeting application or with the Schilit application. The Office Action submits that any file used to store annotations would inherently contain information pertaining to markup entities, the source reference, and the orientation. Applicants respectfully disagree. Firstly, "any file" as asserted in the Office Action is not an XML file. Further,

as stated above, the specific tags and fields recited in the claims are not even remotely inherent or obvious for XML. In addition, there is no suggestion to use an XML file in the form of Schilit's annotation database. In this regard, there is no motivation to combine Schilit with XML.

In view of the above, Applicants submit that these dependent claims are allowable over the cited references.

Moreover, the various elements of Applicant's claimed invention together provide operational advantages over NetMeeting and Schilit. In addition, Applicant's invention solves problems not recognized by NetMeeting and Schilit.

Thus, Applicant submits that independent claims 1, 11, and 20 are allowable over NetMeeting and Schilit. Further, dependent claims 2-10, 12-19, and 21-29 are submitted to be allowable over NetMeeting and Schilit in the same manner, because they are dependent on independent claims 1, 11, and 20, respectively, and thus contain all the limitations of the independent claims. In addition, dependent claims 2-10, 12-19, and 21-29 recite additional novel elements not shown by NetMeeting and Schilit.

III. Conclusion

In view of the above, it is submitted that this application is now in good order for allowance and such allowance is respectfully solicited. Should the Examiner believe minor matters still remain that can be resolved in a telephone interview, the Examiner is urged to call Applicant's undersigned attorney.

Respectfully submitted,

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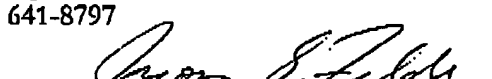
By: 
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